

### **REMARKS**

In the Office Action, the Examiner rejected claims 1-18. By this paper, Applicant amended claim 12 for clarification of certain features to expedite allowance of the present application. This amendment does not add any new matter. Upon entry of this amendment, claims 1-18 remain pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendment and the following remarks, Applicant respectfully requests reconsideration and allowance of all pending claims.

### **Claim Objections**

In the Office Action, the Examiner objected to claim 12 as depending on claim 12. Applicant amended this claim to depend on claim 8. In view of this amendment, Applicant respectfully requests the Examiner withdraw the objection to this claim.

### **Claim Rejections under 35 U.S.C. § 102**

In the Office Action, the Examiner rejected claims 1-18 under 35 U.S.C. § 102(b) as being unpatentable over Faris et al. (U.S. Patent Publication No. 2001/0008721, hereafter "the Faris reference"). Applicant respectfully traverses these rejections.

### **Legal Precedent**

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicant need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention "in as complete detail as contained in the ... claim" to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

***Claim Features Omitted from Cited Reference***

Turning to the claims, the present independent claim 1 recites, *inter alia*, “a battery module adapted to removeably fit into the battery bay, wherein *the battery module comprises* ... at least one storage compartment located adjacent the battery cell.” (Emphasis added.) Similarly, independent claim 8 recites, *inter alia*, “a battery module having a battery and a storage compartment,” and independent claim 14 recites, *inter alia*, a “module comprising a battery cell and a storage compartment adjacent the battery cell.” (Emphasis added.)

**Claim 1**

In the Office Action, the Examiner specifically stated:

Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Faris (US 2001/0008721).

With respect to claim 1, Faris discloses a portable computer, comprising:

a housing having a battery bay (639 and 639C in Fig. 6A); and  
a battery module adapted to removeably fit into the battery bay (640 in Fig. 6A and 6B and Fig. 8A), wherein the battery module comprises at least one battery cell adapted to provide power (641 in Fig. 6A and 6B and Fig. 8B and 655 in Fig. 7A) and at least one storage compartment located adjacent the battery cell (Fig. 8B and 643 in Fig. 6A and pg 6 para 0062 ln 8-12). Office Action, page 2

The Examiner’s rejection is flawed for a number of reasons. For instance, the cited reference does not teach or suggest a battery module that “*comprises* ... at least one storage compartment,” as recited by independent claim 1. (Emphasis added.) In sharp contrast, the cited reference teaches a storage compartment 643 that is *separate from* a fuel cell power module 640. *See* Farris, paragraph 62. Indeed, these two components are not remotely near each other, much less adjacent in the Farris reference. The Farris reference teaches affixing the storage compartment 643 to the exterior surface of the battery storage bay or, in an alternative embodiment, integrally forming the storage compartment 643 within the power consuming device. *Id.* Conversely, the fuel cell power module 640 “is designed for insertion *within* the battery storage bay 639C.” (Emphasis added.) Farris, paragraph 61. In other words, the fuel cell module 640 and the storage compartment 643 taught by the Farris

reference are attached to different portions of the power consuming device. Thus, the Farris reference does not teach or suggest a battery module that “*comprises* ... at least one storage compartment,” as recited by claim 1. (Emphasis added.) In view of this deficiency, the cited reference cannot anticipate independent claim 1 and its dependent claims.

#### **Claim 8**

In the Office Action, the Examiner specifically stated:

With respect to claims 8 and 9, the method steps will be met during the normal operation of the invention described above by Faris (Fig. 8A, 8B, 6A and 6B). Office Action, page 3.

For the same reason as claim 1, the Examiner’s rejection of independent claim 8 is flawed. Independent claim 8 recites, *inter alia*, “a battery module having a battery and a storage compartment.” (Emphasis added.) However, as explained above, the Farris reference teaches a storage compartment 643 on a different portion of the power consuming device than the fuel cell module 643. Farris, paragraphs 61-62. Thus, the fuel cell module 643 of the Farris reference does not *have* a storage compartment 643. Accordingly, the Farris reference does not teach or suggest *all* the features of claim 8 and cannot anticipate claim 8 or its dependent claims.

#### **Claim 14**

In the Office Action, the Examiner specifically stated:

With respect to claim 14, Faris discloses an electronic device, comprising:

- a housing (610 in Fig. 1A and 639 in Fig. 6A);
- a battery bay formed in the housing (612 in Fig. 1B and 639C in Fig. 6A);
- a module removeably coupled to the battery bay, the module comprising a battery cell and a storage compartment adjacent the battery cell (611, 613 and 614 in Fig. 1B and 640 and 643 in Fig. 6A, 6B and 8B). Office Action, page 4.

The Examiners rejection of claim 14 is improper. Independent claim 14 recites, *inter alia*, a “module comprising a battery cell and a storage compartment adjacent the battery cell.” (Emphasis added.) In sharp contrast, the Farris reference teaches a fuel cell module

640 that is independent of the storage compartment 643, as explained above. That is, the fuel cell 640 of the Farris reference does not *comprise* a storage compartment 643. Accordingly, the cited reference cannot anticipate independent claim 14 and its dependent claims.

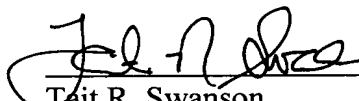
For these reasons among others, Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. § 102.

**Conclusion**

Applicant respectfully submits that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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